

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

REMARKS

Reconsideration and allowance is respectfully requested. The listing of claims replaces all prior versions and listings of claims in the application. Claims 15, 18 and 23 are amended. New Claims 24 and 25 are added.

Background

Before Applicants' invention there existed conferencing systems such as the one set forth in Prasad. Prasad describes a system wherein a conference is set up involving a central computer. The central computer has a radio frequency (RF) communication capability. A person who wishes to attend the conference carries a laptop computer into the conference. The laptop also has a RF communication capability. When the laptop establishes RF communication with the central computer, the attendee is automatically enrolled into the conference. Thereafter the attendee can use the laptop to share information with other attendees of the conference.

The inventors of the present application, however, recognized a problem existing in the prior art. Individuals would go to a conference, and enroll at the conference using their email addresses. The present specification explains a situation wherein an individual goes to a conference and gives out his primary business email address. The individual's primary business email address is thereafter spammed with unwanted advertisements and solicitations. This unwanted spam may be so voluminous that it interferes with the individual's future use of his/her primary business email account. This can be a major problem that discourages use of electronic conferencing systems that use email addresses to allow communication between attendees. (Such a spam problem can dissuade well-known and influential people such as executives of large companies from using an electronic conferencing system because these well-known people are afraid of being pestered by all manner of people trying to sell

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

them and meet them). This spam problem is nowhere recognized in any of the Examiner's six cited references.

Applicants' patent application discloses a novel conferencing system, wherein each attendee has a "personal proxy" as well as a "real identity," and where the personal proxy is maintained on the conference organizer's computer system. JENS@COMDEX.COM is the example given of a "personal proxy." It involves a mailbox and storage space that allows the attendee (Jens in this case) to receive information and communicate with others at the conference (Comdex in this case). JENS@OPENGRID.COM is the example given of a "real identity" (Jens primary business email address at the company OpenGrid Inc.) Paragraph 15 of Applicants' specification explains that the attendee (Jens in this case) does not want others at the Comdex conference to be able to send unwanted advertisements and solicitations to JENS@OPENGRID.COM. By providing Jens with the personal proxy, Jens is able to receive information and communicate with others at the Comdex conference without divulging his primary JENS@OPENGRID.COM email address. If the attendee gets spammed by solicitors at the conference and afterwards, then it is the personal proxy mailbox that will be spammed, not the attendee's primary business email mailbox. The attendee can move interesting information from the personal proxy into the attendee's real identity, if the attendee so chooses. In one embodiment¹, the personal proxy mailboxes maintained on the conference organizer's system are only accessible for a time period that is roughly coextensive with the duration of the conference. After the conference is over, the organizer's conference system deletes the personal proxies, thereby freeing up the storage space on the organizer's computer system for other uses.²

¹ The embodiment of EXAMPLE 2, paragraphs 29-35.

² The above paragraphs are provided as an overview of the specification. Because these statements are a simplification, they are inaccurate and incomplete at some level of detail and they are not to be considered to be a gloss on the specification. For an accurate meaning of claim terms, refer directly to the specification and claims.

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

Claims 1-6 and 9-11

Claims 1-6 and 9-11 are rejected under 35 U.S.C. §103 over Prasad (USP 6,237,026) in view of Pivowar (USP 6,308,201). The Examiner cites Prasad's computer conferencing system, but acknowledges that "Prasad did not explicitly state that his system utilized personal proxies..." (Office Action, page 3, lines 1-2). The Examiner therefore cites the Pivowar reference and states "Pivowar's system does disclose this though. Pivowar uses a computer system for each user as a proxy to store information which is separate from the user's personal digital assistant or in this case, their real identity" (Office Action, page 2-5). The Examiner maintains that item 106 in Figure 1 is a personal proxy. The Examiner maintains that item 102 is a real identity. (Office Action, page 4, lines 2-3). The Examiner concludes that "since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Prasad by adding the ability to use a personal proxy to aid users in sharing data as provided by Pivowar...(Office Action, page 3, lines 7-10).

a. Neither Prasad Nor Pivowar Discloses A Personal Proxy, So No Combination Of Prasad And Pivowar Would Either.

Applicants respectfully disagree with the Examiner's conclusion that Pivowar discloses a personal proxy. Applicants traverse the §103 rejection.

Item 102 of Pivowar figure 1 is not a personal proxy and none of the sections of Pivowar pointed to by the Examiner state that item 102 is a personal proxy. Pivowar (See Figure 1) discloses a system including a "server" 104 that communicates with the various "client" computers 106. PDA 102 is not a client. Communication occurs between a server 104 and a client 106. Once client 106 has received a message, a user may use PDA 102 to view the message, but that does not make PDA 102 a client. Nowhere does Pivowar disclose or suggest that server 104 could send a message to PDA 102 separate and apart from client computer 106. PDA 102 does not have an address usable for

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

receiving messages from server 104 separate and apart from client computer 106. PDA 102 cannot therefore be a "real identity." If PDA 12 cannot be a real identity, then client 106 cannot be a "personal proxy" for that real identity. Rather than Pivowar disclosing two clients (102 and 106), Pivowar is only disclosing one client (106).

The Examiner points to a section of Pivowar that states "the client computer 106 may be excluded in favor of incorporating the necessary components thereof into either server 104, the PDA 102, or an unillustrated communication interface device." (col. 5, lines 1-6). This section, as Applicants understand it, is suggesting that the client functionality can be built into PDA 102 so that computer 106 is no longer needed. The result would be just one device on the client side, namely the PDA. There would only be one client device where messages could be received. Due to there being only one client, there would not be a "real identity" that is separate from a "personal proxy." Applicants therefore submit that this section of Pivowar neither discloses nor suggests a personal proxy.

Not only does Pivowar not disclose a personal proxy, but Prasad also does not disclose a personal proxy. The Examiner acknowledges that "Prasad did not explicitly state that his system utilized personal proxies for each attendee..." (Office Action, page 3, lines 1-2). Applicants agree, but would go further. Prasad also does not implicitly disclose a personal proxy. There is absolutely no disclosure whatsoever of a personal proxy in Prasad.

Accordingly, because neither Prasad nor Pivowar discloses a personal proxy, it is submitted that no combination of Prasad and Pivowar can involve a personal proxy. The §103 rejection of Claims 1-6 and 9-11 is therefore improper and should be withdrawn.

b. No Prima Facie Rejection

The Office Action points to no motivation or suggestion in the art "to modify the system of Prasad". The Examiner states that adding the ability to use

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

a personal proxy “would allow users more control over their data including what data they decide to share or not to share in a conferencing environment.” (Office Action, page 3, lines 10-11).

First, Applicants submit that the reason given by the Office Action does not make sense. Applicants submit that the Prasad reference would not suggest to one of ordinary skill that “more control” of data is needed. Applicants also submit that one of ordinary skill would not conclude that more control of data could be provided by adding an ability to use a personal proxy. How does providing a personal proxy allow more control over data? Could the Examiner please explain this? Applicants do not see how the Examiner’s motivation to modify Prasad makes any sense.

Second, the Examiner is respectfully requested to consider the problem recognized by the inventors when considering whether the claimed invention as a whole would have been obvious. Invention can be had in recognizing a problem, when once the problem is recognized the solution would be apparent to one of ordinary skill. Applicants note that there is no recognition in either Prasad or Pivowar that there could be a spamming problem – there is no recognition in any reference cited by the Examiner that people may be dissuaded from using electronic conferencing systems due to their divulging their email addresses and then being spammed at the conference, and after the conference. The fact that this problem is not recognized in any cited reference is further evidence of the non-obviousness of Applicants’ invention.

In conclusion, because the Examiner’s “more control over data” reason does not make sense, and because neither Prasad nor Pivowar mentions a problem that a personal proxy would ostensibly solve, it is submitted that the Office Action fails to identify a motivation or suggestion *in the art* to make the hypothetical combination. The §103 rejection is therefore improper. Withdrawal of the §103 rejection is requested.

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

Claims 7, 8, 14-18 and 21-23

Claims 7,8, 14-18 and 21-23 are rejected under 35 U.S.C. §103 over the hypothetical Prasad/Pivowar combination, in still further view of Thurlow (USP 6,057,841). The Office Action states that “the combination of Prasad and Pivowar did not disclose the use of a mailbox at both the client and the personal proxy.” The Examiner therefore cites Thurlow and states “However, Thurlow’s email system points to the known trend of maintaining both of these mailboxes for each user. Since the inventions encompass the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to modify the combination of Prasad and Pivowar by adding the ability to maintain at both the client and the personal proxy as provided by Thurlow...” (Office Action, page 7, lines 3-9).

Applicants respectfully disagree with the Examiner and traverse the rejection. Pivowar does not, despite what the Examiner says, disclose a “client” and a “personal proxy”. Client computer 106 in Pivowar is not a personal proxy for PDA 102. Accordingly, even if Thurlow were to teach the existence of a first mailbox on a client and another mailbox on a personal proxy, there would still be no personal proxy in the Prasad/Pivowar combination to apply the Thurlow teaching to.

Secondly, Thurlow does not teach a mailbox at a client and a separate mailbox at a personal proxy. Thurlow describes an ordinary email client like OUTLOOK 97, where a rule can be set to forward emails to another email client account, if there is another email client account. Applicants do not contest that such email client software existed at the time of their invention. Applicants do, however, contest that the fact that such client software existed would have made providing Applicants’ specific “personal proxy” obvious. There is no disclosure or teaching in Thurlow that the email address of the client to whom the email is forwarded is not divulged to or known to the entity sending the email. There is certainly no teaching in Thurlow that the ability to hide this email address should

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

be advantageously applied to conferencing software. As explained above, the Prasad/Pivowar combination does not even include a "personal proxy" for a second "real identity". Applicants submit that the mere existence of the email forwarding of Thurlow, considered in combination with the Prasad/Pivowar, would not have suggested a personal proxy in a conferencing system.

Reconsideration and allowance of Claims 7, 8, 14-18 and 21-23 is respectfully requested.

Dependent Claim 18

Applicants draw particular attention to dependent Claim 18 that recites "wherein the indication of the personal proxy mailbox has a first part and a second part, the first part being indicative of the name of the attendee, the second part being indicative of a conference name." The Examiner acknowledges that "Thurlow is not explicit in his naming scheme for user mailbox addresses" but the Examiner states "Here, however, ***it is sufficiently shown*** above that the users maintain a personal proxy mailbox and naming schemes for mailboxes such as this were well known in the art at the time of the applicant's invention. Thus it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use a two-part naming scheming such as the one in claim 18." (emphasis added)(Office Action, page 7, lines 13-18).

Applicants disagree. ***It is not "sufficiently shown"***. The rejection fails to amount to a prima facie §103 rejection. Claim 18 does not just recite a two-part naming scheme. It specifically recites that the second part is indicative "of a conference name." The Examiner's attention is directed to the example in the specification where multiple attendees of the same conference all have personal proxy names that end in the same conference name. See, in Figure 1, for example "JENS@COMDEX.COM" and "ART@COMDEX.COM." This is an important aspect of Claim 18. The Examiner cannot just brush this "indicative of a conference name" limitation out of the way and ignore it. The reason this aspect is not in the cited references is that it was in fact not obvious.

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

The §103 rejection of Claim 18 is not a prima facie §103 rejection. Withdrawal the improper rejection and allowance of Claim 18 is respectfully requested.

Dependent Claim 22

Applicants draw particular attention to dependent Claim 22 that recites "wherein the conference organizer's computer system allows a conference attendee to access his/her personal proxy mailbox only for a period of time that roughly corresponds to the duration of the conference." The Office Action hardly mentions the subject matter of Claim 22, but merely cites "(Prasad, column 5, lines 33-39)". Evidently the Examiner maintains that the cited section of Prasad discloses limiting access to a mailbox for a period of time that roughly corresponds to the duration of a conference. Applicants disagree. The section of Prasad mentions a commencement time for the conference and a conclusion time for the conference, but the section contains absolutely no disclosure of limiting access to any mailbox to a period of time. Where does the Examiner see this disclosure in this passage? ***If the Examiner does not withdraw the rejection of Claim 22, the Examiner is requested to point out in the next office action specifically where Prasad discloses limiting access to a mailbox to some period of time.*** The rejection of Claim 22 is improper. Reconsideration and withdrawal of the §103 rejection of Claim 22 is requested.

Dependent Claims 12, 13, 19 and 20

Dependent Claim 12 further recites that the part of the updated conference information that is moved into the personal proxy is an "electronic business card". Dependent Claims 13 and 19 further recite a "message board". Dependent Claim 20 further recites displaying on the wireless device a "map of the conference location." To reject each of these dependent claims, the Office Action depends on the same Prasad/Pivowar combination mentioned above with respect to the independent claims. For disclosure of the additional limitations in

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

the dependent claims, the Office Action piles on additional references (Adamson for disclosure of an electronic business card; Hoffer for disclosure of a message board, and Bouve for disclosure of a map). Applicants respectfully traverse these rejections.

First, it appears that the Examiner is impermissibly picking and choosing selected part of numerous prior art references to create a facsimile of Applicants' claimed invention. The suggestions for how to pick and choose are not coming from the references themselves, but rather it is submitted that the Examiner is using Applicants' claims as a template. This is an improper hindsight analysis that the Court of Appeal for the Federal Circuit has held to be improper. The Examiner is to put Applicants' invention out of this mind, and look at the cited references for what they would have fairly suggested to one of ordinary skill.

Second, because each of the rejections of dependent Claims 12, 13, 19 and 20 depends on Pivowar disclosing a personal proxy, each of these rejections fails for the same reason that the rejections of the independent claims fail (see the discussion above). Adamsom, Hoffer and Bouve fail to cure the shortcomings of the Prasad and Privowar references. Not one of the references discloses a personal proxy, so no combination of the references can amount to Applicants' claimed inventions.

Allowance of Claims 12, 13, 19 and 20 is requested.

New Claims 24 and 25

New Claim 24 recites "maintaining a plurality of personal proxies for a conference" where each conference attendee also has "an email mailbox that is different than the personal proxy." Claim 24 further recites "providing the personal proxy names to the attendees of the conference," and further recites that "each attendee is allowed to access his/her personal proxy only for a period of time that roughly corresponds to the duration of the conference."

New dependent Claim 25 further recites that each personal proxy has a name that has "a first part and a second part, the first part being indicative of a

Applicants: Jens Horstmann et al
Serial No.: 09/864,479
Filing Date: May 23, 2001
Docket No.: OG-003

name of the conference attendee, the second part being indicative of the name of the conference." Claim 25 further recites that the "email mailbox of an attendee is the primary business email address of the attendee." (the term "the" here is not believed to make the term "primary business email address" indefinite because "primary" is singular and there can only be one "primary" business email address – if the Examiner would like, however, the term "the" can be changed to "a").

The subject matter of new Claims 24 and 25 is nowhere disclosed or suggested in the cited references, whether the references are considered singly or in combination. Consideration and allowance of new Claims 24 and 25 is requested.

Conclusion

In view of the above amendments and remarks, Claims 1-25 are in condition for allowance. A Notice of Allowance is requested. If the Examiner would like to discuss any aspect of this application, the Examiner is requested to contact the undersigned at (925) 621-2115.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail on the date indicated below and is addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

By T. Lester Wallace
T. Lester Wallace

Date of Deposit: March 17, 2005

Respectfully submitted,

T. Lester Wallace

T. Lester Wallace
Attorney for Applicants
Reg. No. 34,748
Customer Number 24,941

Silicon Edge Law Group LLP
6601 Koll Center Parkway
Suite 245
Pleasanton, CA 94566
(925) 621-2115